

Application No.: 09/963,551

REMARKS

Claims 2 and 8 are independent and stand rejected under 35 U.S.C. § 102 as being anticipated by Kuchta et al. '831 ("Kuchta"). This rejection is respectfully traversed for the following reasons.

In order to expedite prosecution, Applicants' representative initiated a telephone interview with Examiner Thompson to discuss the merits of the present application. Applicants' and Applicants' representative would like to thank Examiner Thompson for his courtesy in conducting the interview and for his assistance in resolving issues, as well as his detailed commentary in the outstanding Advisory Action which provided a clear depiction of the Examiner's position. A summary of the discussion follows.

Claim 2 recites in pertinent part, "wherein image data ... is *transferred from the image memory to the storage medium* while the series of images is presented by the display." Claim 8 similarly recites in method format, "temporarily storing the compressed image data on an image memory; ... storing the compressed image data successively on a storage medium while the series of images is presented on a display based on the image data stored on the display memory."

In the Advisory Action and during the interview, the Examiner clarified that he was interpreting element 24 of Kuchta as both the claimed image memory and the claimed storage medium. However, as discussed during the interview, element 24 of Kuchta is merely a memory card that does not transfer data from one area therein to another in a manner corresponding to the claimed data storing/transferring process. Accordingly, Kuchta does not disclose or suggest image data that is transferred from the alleged image memory 24 to the alleged storage medium 24 in the manner enabled by the present invention.

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As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Kuchta does not anticipate claims 2 and 8, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 2 and 8 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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